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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/830,875	05/02/2001	Kunihiko Yano	Q64302	5307

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2100 Pennsylvania Avenue N W  
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EXAMINER

NORDMEYER, PATRICIA L

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 11/06/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

0209

<b>Office Action Summary</b>	Application No. 09/830,875	Applicant(s) YANO, KUNIIHIKO	
	Examiner Patricia L. Nordmeyer	Art Unit 1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 August 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 12-17 and 28-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-17 and 28-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other:  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 1, 2003 has been entered.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 12 and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "a transparent cover glass substrate of thermoplastic resins" in claims 12 and 28 is unclear, which render the claims vague and indefinite. The claim language is unclear, and it reads as the substrate is made of a glass material instead of a thermoplastic resin material.

Correction/clarification is required.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 12 – 14, 16, 17 and 28 – 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taniguchi (USPN 4,765,729) in view of Friedman (USPN 6,159,397).

Taniguchi discloses an optical article that uses a resin substrate (Column 2, lines 65 - 68 and Column 9, lines 42 - 452) as part of an optical article. An antireflection film (coating) is formed on the outside of the substrate (Column 18, lines 1 - 3). Before placing the antireflection coating on the substrate, a hard coat film is placed on the substrate (Column 9, lines 53 - 57 and Column 18, lines 20 - 22). A film that is formed by coating and curing contains silica (silicon oxide) particles with diameters between 1 to 200 nm (Column 3, lines 22 - 23) and an organic silicon compound with hydrolysable groups (Column 3, line 52 to Column 5, line 15) forms the hard coating. Both the anti-reflection coating and the hard coating film are formed on both the inner and outer surfaces of the cover glass substrate (Column 14, lines 8 - 9). The antireflection film can have a decorative part by dyeing the film (Column 9, lines 57 - 61). The surface of the antireflection is treated to give it oil and water repellent characteristics (Column 2, lines 37 - 40). However, Taniguchi fails to disclose an anti-reflection coating formed on the inner surface of the cover glass substrate without the hard coating film interposed between them.

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Friedman teaches a transparent substrate, lens, (Column 3, lines 56 – 59) having a concave surface (Figure 2) made from thermoplastic resin material (Column 5, lines 7 – 11) with an antireflection coating formed on the inner and outer surfaces of the lens without a hard coat film (Column 5, lines 47 – 50 and Column 14, lines 32 – 33) in a lens for the purpose of making an optical article that may be used for a variety of different activities including athletics, training and display terminals.

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the an optical article with a hard coat film and antireflection coating on the outer surface and an antireflection coating on the inside surface with a film base in Taniguchi in order to make an optical article that may be used for a variety of different activities including athletics, training and display terminals as taught by Friedman.

Regarding the limitations of the hard coating film is an organic thin film transferred from a transfer foil in claims 12 and 29, the anti-reflection coating undergoing water and oil repellent treatment in claims 16 and 32 and the anti-reflection coating having a decorative part by printing in claim 31, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 946, 966 (Fed. Cir. 1985) and MPEP §2113. In this case, the limitation of the hard coating being transferred foil and undergoing water and oil treatment are methods of production and therefore

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do not determine the patentability of the product itself. Process limitations are given little or no patentable weight. The method of forming the product is not germane to the issue of patentability of the product itself. Further, when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. *In re Brown*, 459 F.2d 531, 173 USPQ 685 (CCPA 1972); *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974).

Regarding the limitation of the cover being used to cover the view plane of a liquid crystal display placed in a housing of a portable apparatus and to make visible the view plane of the display unit in claim 17 and the limitation of the cover being used to cover the view plane of a liquid crystal display placed in a housing of a portable apparatus and to make visible the view plane of the display unit through a gap between the cover glass and view plane of the liquid crystal display in claim 28, it has been held that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Although claim 28 claims a gap between the cover glass and liquid crystal display, the

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gap does not add to the structure of the cover glass itself but is directed towards the how the glass would be used in combination with the liquid crystal display.

6. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Taniguchi in view of Friedman as applied to claims 12 – 14, 16, 17 and 28 – 32 above, and further in view of Mase et al. (USPN 5,693,366).

Taniguchi, as modified with Friedman, discloses the claimed cover glass except for the primer layer being interposed between the cover glass substrate and the hard coating film.

Mase et al. teaches a primer layer formed from thermosetting polyurethane against the plastic substrate and covered with the hard coat layer (Column 4, lines 21 – 23 and Column 5, lines 16 – 30) in an optical article that uses a resin substrate (Column 2, lines 32 - 35) as part of an optical lens for the purpose of making a lens that has greater resistance to impact.

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the polyurethane resin primer in the modified Taniguchi in order to have a lens that has greater resistance to impact as taught by Mase et al.

### ***Response to Arguments***

7. In response to applicant's arguments, the recitation cover glass has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not

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accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). The applied art meets the structural limitations of the claimed invention.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Nordmeyer whose telephone number is (703) 306-5480. The examiner can normally be reached on Mon.-Thurs. from 7:00-4:30 & alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on (703) 308-4251. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Patricia L. Nordmeyer  
Examiner  
Art Unit 1772

*pln*  
pln

*[Signature]*  
HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
1772

10/31/03